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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,876	10/21/2005	Alfred Heimann	20496-478	8749
21890	7590	10/10/2007		
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER ROSS, DANA	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 10/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,876

Applicant(s)

HEIMANN, ALFRED

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/23/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Examiner notes that Applicant states on the IDS that DE 10035718A is provide with a translation. It is noted that the translation provided by Applicant is not in English.

Drawings

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

There are currently no drawings provided for the current Application. Examiner notes that Applicant's priority document to the 371 of PCT/EP03/08671 of 8/06/2003 contains Figures 1 and 2 that appear to correlate to Applicant's current invention and these drawings are used for this examination. It is noted that the priority document to the 371 does not include a Figure 2.

Applicant is required to provide copies of Figures 1 and 2 as disclosed in Applicant's disclosure in accordance with requirements of 37 CFR 1.81(c).

Specification

The disclosure is objected to because of the following informalities: The disclosure is replete with grammatical errors making it difficult to determine Applicant's invention.

For example, Page 1, 1st paragraph, lines 5-6; it is not clear what is meant by the phrase "...either being provided with a chuck and with a back center integrated into the chuck". It is not clear what is being claimed by the chucks 6 and 7 in addition to the equalizing clamping jaws 24 (see page 10, last paragraph, page 3, lines 12-14). Page 6, paragraph 3 discusses "equalizing chucks". It is not clear from the disclosure the differences in the claimed terminology.

See also Page 5, paragraph 4 that addresses speed in minutes only. It is not clear if this is revolutions per minute, feet per minute, meters per minute or another speed.

See also page 9, paragraph 4, line 7 which states "8 and 9 simultaneously". This should be "8 and 9 simultaneously".

The above is not all-inclusive. Applicant should review the disclosure to ensure correct grammatical disclosure of Applicant's invention.

Appropriate correction is required.

A statement that states the changes contain no new matter must accompany all changes filed.

Claim Objections

3. Claim 3 is objected to because of the following informalities: The phrase "fixed or ovable" should be changed to "fixed or movable". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 6, recites the limitation "the chucks". There is insufficient antecedent basis for this limitation in the claim.

Claim 3, it is not clear from the disclosure how the at least one back center is "fixed or movable" in a direction.

Claim 4, it is not clear from the disclosure what is being claimed by the term " 5min^{-1} and 1500min^{-1} ". It is not clear if this is revolutions per minute, feet per minute, meters per minute or another speed.

Claim 5, it is not clear from the disclosure what is being claimed by the chucks being "designed so as to be equalizing".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 200153024 (Kumano).

Examiner notes that WO 200153024 is not in the English language, therefore all references to the patent of Kumano will be made to the US English equivalent document US Pat. No. 6,640,678 (Kumano).

Kumano teaches two spindles 2 and 4 with chucks 5 and 6, chuck 6 with claws for holding the workpiece (see figure 1) and fixable and movable in the Z direction (see col. 3, lines 9-22, figure 2) on spindle guide 9 for moving spindle 4, four tool turrets 8a-8d (both turning and milling) in two sets mounted on a tool slide movable and positional individually in the X and Z directions (see col. 1, lines 24-30, col. 2, lines 26-46, col. 4, lines 28-39, figure 1, for example).

Kumano teaches it is well known for the workpiece spindles to rotate for both high-speed rotation and low speed rotation (see col. 3, lines 9-15)

Examiner notes that whereas Kumano teaches the function terminology of claim 1 (i.e. capable and can be), it is further noted that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15

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USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

Examiner notes that the claims are not clear and therefore is providing an additional rejection of claims 3-5 under 35 USC 103(a).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano in view of US Pat. No. 6,684,500 (Kohlhase et al.).

Kumano teaches all aspects of claim 1 as discussed above.

Kumano does not expressly disclose the speed or specifics of the chucks.

Kohlhase teaches it is well known in the art to machine using both milling and turning tools at both low and high speeds, particularly cutting speeds from 10 rpm (see col. 2, lines 12-17) to 130 m/min to over 500 m/min (see col. 2, lines 51-58) and 1000 rpm for spindles of crankshafts (see col. 3, lines 1-9).

Kohlhase teaches it is well known in the art to have chucks for use in crankshafts that includes an end journal 22 and end flange 21 with jaws 7 preferably floating or centeringly engaging the periphery of the end flange 21 or end journal 22 without clamping action between the center points 8 (see col. 7, lines 48-54).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the machine as taught by Kumano to run at whatever speed was desired or expedient depending on the machining being performed as taught by Kohlase and to use a specific chuck arrangement as taught by Kohlase depending on the workpiece being machine for the purpose of machining a crankshaft where setting and idle times are minimized and transportation to another machine is avoided and both large batch sizes and small numbers of items are economically machined (see Kohlase, abstract).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/
Primary Examiner
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